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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,895	12/06/2005	Michael Soukup	SOUKUP-PCT-US-1	2855
7590 03/18/2008				
OBER / KALER c/o Royal W. Craig Suite 800 120 East Baltimore Street Baltimore, MD 21202			EXAMINER RODGERS, PATRICK G	
			ART UNIT 1791	PAPER NUMBER
			MAIL DATE 03/18/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/559,895

Applicant(s)

SOUKUP, MICHAEL

Examiner

PATRICK G. RODGERS

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 and 13-20 is/are rejected.
- 7) ☒ Claim(s) 9 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is the initial Office action based on the 10/559895 application filed December 6, 2005. Claims 7-9 and 13-20 are currently pending and have been given consideration below. The examiner notes that claims 1-6 and 10-12 have been canceled in light of applicant's Preliminary Amendment filed on December 6, 2005 and have not been given consideration below.

Specification

1. The use of the trademarks Mylar®, Treasure Crystal Cote® and others has been noted in this application. Trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

2. The disclosure is objected to because of the following minor informality: At paragraph [0030], lines 4-5, "The clear a polyester film such as..." should be changed for grammatical correctness. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9 and 15 contain the trademark/trade name Mylar®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the

claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a polyester film and, accordingly, the identification is indefinite.

5. Claim 19 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 recites the limitation "applying a third finish coat over said second finish coat." There is insufficient antecedent basis for the "second finish coat" within this claim. The examiner believes a minor informality is present in the preamble of this claim, at line 1 of claim 19, the phrase "according to claim 17," is believed to be read as "according to claim 18." The examiner will withdrawal the rejection should appropriate correction occur.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 7-9 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tandeau De Marsac (FR Patent No. 2784329) in view of Deubel (US Patent No. 2116752).

Regarding claims 13 and 17, Tandeau teaches,

A lamination process for insect wings, comprising the steps of: mixing a liquid epoxy resin; applying a layer of said liquid epoxy resin to a sheet of thin smooth material (Tandeau, [0003], (resins for inclusions) and [0004], lines 5-10 and Figure 1); affixing an insect wing to said layer of liquid epoxy resin on said sheet ([0003], line 1 and Figure 1, layer of scales '3'); allowing said layer of liquid epoxy resin to dry, (The examiner notes that it would be inherent to one of ordinary skill in the insect lamination art to allow any such layer, being an epoxy resin or fixative layer, to dry before further progress during a lamination process); applying a layer of fixative to an exposed side of said insect wing [0004]; allowing said layer of fixative to dry; cutting along an outer perimeter of said insect wing to separate said wing from a remainder of said sheet, (Examiner notes that it would have been readily appreciated that in a jewelry

manufacturing process that excess sheeting would have been cut and removed beyond the butterfly or insect wing);

smoothing said perimeter of said cut-out insect wing [0007];

Tandau does not explicitly teach applying a first layer of clear lacquer/resin over said layer of fixative, however Deubel teaches,

applying a first layer of clear lacquer/resin over said layer of fixative (Deubel, right column, lines 10-13);

allowing said first layer of lacquer/resin to dry (Deubel, right column, l 12);

applying a second layer of clear lacquer/resin over said first layer of clear lacquer/resin;

allowing said second layer of lacquer/resin to dry;

applying a third layer of clear lacquer/resin over said second layer of clear lacquer/resin; and

allowing said third layer of lacquer/resin to dry; (The examiner notes that it would have been

obvious through routine experimentation to one of ordinary skill in the art at the time of the

invention to have repeated lacquer/resin applications in order to obtain desired decorative effects

one wished to attain and to provide the necessary protection in order to preserve the butterfly or insect wing);

wherein a preserved laminated insect wing suitable for use in all manner of decorative design

results (Deubel, right column, lines 16-20) and (Tandau, [0009], last line).

Insofar as Tandau and Deubel are analogous art from the same field of endeavor of butterfly lamination art, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have combined the teachings of Tandau and Deubel to include applying a

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lacquer/resin layer as taught by Deubel in order to provide increased protection for the fragile butterfly wing (Deubel, left column, lines 10-13).

Regarding claims 18 and 19, given the teachings of Tandeau and Deubel it would have been obvious to one of ordinary skill in the insect lamination art at the time of the invention to apply a second or third finish coat over said first finish coat; and allowing said second or third finish coat to dry. This would have been appreciated through routine experimentation to one of ordinary skill in the art at the time of the invention in order to obtain desired decorative effects and to provide the necessary protection in order to preserve the butterfly or insect wing, (Deubel, left column, lines 20-26, (such changes in the ingredients, proportion and manner of combining same,...)).

Regarding claim 7, Tandeau teaches,

A lamination process for extremely fragile butterfly wings, comprising the

steps of: affixing a natural butterfly wing to a first sheet of self-adhesive ultra-thin smooth material ([0003] and Figure 1);

affixing a second sheet of self-adhesive ultra-thin smooth material to the exposed side of said butterfly wing (Figure 1 and [0008];

affixing said first ultra-thin sheet to said layer of liquid epoxy resin on said sheet (Figure 1);

allowing said layer of liquid epoxy resin to dry;

applying a layer of fixative to said second ultra-thin sheet [0004]; allowing said layer of fixative to dry; wherein a preserved laminated butterfly wing suitable for use in all manner of decorative design results, [0009].

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Regarding claims 8-9, 14-15, and 20, Tandeau and Deubel teach the limitations of claims 7 and 13, as referenced above, and Tandeau teaches, further comprising the steps of: drilling a hole through an end of said insect wing (Examiner notes that a butterfly wing is an insect wing and the two are equivalent regarding the application of drilling a hole and affixing a bail to said hole, the applicant must show the criticality regarding as to why a butterfly wing would constitute a special case), and affixing a bail to said hole, wherein a preserved laminated insect wing suitable for use in all manner of jewelry results [Tandeau, [0004], lines 12-13, (conditioning in various ways (punching, cutting, transforming, folding, joining) thus allowing many applications)]. wherein said sheet of thin smooth material is a polyester film (Tandeau, [0007], It would have been obvious to one of ordinary skill in the insect lamination art at the time of the invention to have selected a polyester film as the transparent plastic film taught by Tandeau at paragraph [0007], line 5 and Figure 1, film '1') such as Mylar®, (The examiner notes that the Tandeau invention can make jewelry ([0009], last line) and it would be obvious to one of ordinary skill in the art to drill a hole and affix a bail to said hole in order to make a piece of jewelry).

Regarding claim 16, Tandeau and Deubel as combined teach, A laminated insect wing, comprising: a first layer of a sheet of thin smooth material (Tandeau, [0003] and [0007]); a second layer of a liquid epoxy resin (Tandeau, [0003], line 1, and Figure 1) applied to said first layer; a third layer of a natural insect wing (Tandeau, [0003] and Figure 1, layer of scales'3') affixed to said first and second layer combination (Figure 1); a fourth layer of fixitive applied to the exposed side of said insect wing; a fifth layer of a first application of clear lacquer applied to said fourth layer (Deubel, right column, lines 10-13); a sixth layer of a second application of

clear lacquer applied to said fifth layer; and a seventh layer of a third application of clear lacquer applied to said sixth layer (Deubel, lines 10-13).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Duling et al. (US3717534), Hoffman et al. (US5415903), and Swartz (US3625810) disclose methods for laminating articles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICK G. RODGERS whose telephone number is (571)270-5046. The examiner can normally be reached on M-F 0730-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PGR

/Melvin C. Mayes/
Primary Examiner, Art Unit 1791